

Remarks

Reconsideration of this patent application is respectfully requested, particularly as herein amended.

The Office Action of May 1, 2009, first objects to the drawings under 37 C.F.R. §1.83(a) because a "feature of the invention specified in the claims" has allegedly not been shown. In particular, the Examiner states that "the projections in claim 8 must be shown or the feature(s) canceled from the claim(s)". This position is respectfully traversed for reasons which follow.

Two "Replacement Sheets" of drawings bearing originally submitted Figures 1 to 3 have been submitted with this Reply. No amendments have been made to the illustrated structures. However, the reference numbers applied to each of the figures have been amended to separately identify the "notches" with the reference number "8" and the "projections" with the reference number "8a". Corresponding amendments have also been made to the two paragraphs of the substitute specification (originally submitted with the Reply filed on August 11, 2008) which had previously been amended as part of the Reply which was filed in this matter on March 3, 2009. Entry of the amendments proposed for the drawings, in addition to the corresponding amendments to the specification, is respectfully requested.

As is further demonstrated with reference to the "Replacement Sheets" of drawings submitted with this Reply,

although not numbered, the projections in claim 8 were shown in the drawings for this Patent Application, as originally submitted. Reconsideration and withdrawal of the objection to the drawings under 37 C.F.R. §1.83(a) is, therefore, respectfully requested.

The Office Action of May 1, 2009, next objects to one of the amendments made to the substitute specification by the Reply which was filed on March 3, 2009, under 35 U.S.C. §132(a), because the submitted amendment is alleged to have introduced what is characterized as "new matter" into the disclosure. This position is respectfully traversed for reasons which follow.

The added material which is not considered to be disclosed by the original specification is identified at page 3 of the Office Action, and is said to include the disclosure of "spaced projections for breaking up the seasoning disposed along the drive shaft", which was inserted into the paragraph of the substitute specification filed on August 11, 2008, at page 3, lines 11 to 14.

However, and as previously noted, while not numbered, spaced projections (currently provided with the reference number "8a") were shown in the drawings for this Patent Application, as originally submitted. Consequently, it is respectfully submitted that the amended language presented in the Reply filed on March 3, 2009, did not introduce new matter into the disclosure, but only served to correlate the disclosure with structures which

had been illustrated in the drawings, as originally filed.

It is, therefore, respectfully submitted that appropriate support for the amended language presented in the Reply filed on March 3, 2009, is found in the original drawings, and reconsideration and withdrawal of the objection to the amended language, under 35 U.S.C. §132(a), is respectfully requested.

The specification is further objected to for allegedly failing to provide antecedent basis for claimed subject matter, citing 37 C.F.R. §1.75(d)(1) and Section 608.01(o) of the Manual of Patent Examining Procedure. Specifically identified in connection with this objection are "the projections of the screw... positioned at spaced locations along the screw", as recited in claim 20.

The intended meaning of this statement is not understood because the amendment presented in the Reply filed on March 3, 2009, has already taken steps to present language directed to the "spaced projections... disposed along the drive shaft", to correlate the specification to structure shown in the original drawings. Nevertheless, it is respectfully submitted that with the addition of the reference numbers "8a", indicating two projections at spaced locations along the drive shaft, the objection to the specification for allegedly failing to provide proper antecedent basis for claimed subject matter is overcome. Reconsideration and withdrawal of the objection formulated under

37 C.F.R. §1.75(d)(1) and Section 608.01(o) of the Manual of Patent Examining Procedure is, therefore, respectfully requested.

The Office Action of May 1, 2009, next rejects claims 1, 11 and 20 under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. This rejection is also respectfully traversed in view of the discussion which follows. For purposes of responding to this issue, it has been noted that claim 1 was canceled by the Reply which was filed in this matter on August 11, 2008, and was replaced by claim 8. For this reason, the rejection of claim 1 formulated under 35 U.S.C. §112, first paragraph, will be treated as a rejection of claim 8 in the discussion which follows.

Claim 8 is rejected for reciting "a plurality of notches including projections for breaking up the seasoning" (emphasis supplied in the Office Action), and claim 20 is rejected for reciting that "the projections of the screw are positioned at spaced locations along the screw". It is respectfully submitted that these rejections are left moot by the foregoing discussion of these recitations, demonstrating appropriate support for each recitation.

Claim 11 is rejected for the recitation "wherein the notches of the screw cause the seasoning to fall into the grinder". Once again, this rejection is not understood because support for such structure has already been identified, and can be found at lines 25 to 27 of page 3 of the English translation

of the specification submitted when steps were taken to enter the U.S. national stage of the International Application on which this Patent Application is based, i.e., "movement of the screw 7 with its notches 8 breaks up the salt, facilitating grinding as the salt falls into the grinding device...." (emphasis added).

Once again, it is submitted that the person skilled in the art would readily understand from this that "the notches of the screw cause the seasoning to fall into the grinder", and a further reconsideration and withdrawal of the rejection of claim 11 under 35 U.S.C. §112, first paragraph, is earnestly solicited.

It has been noted that the Examiner addresses this discussion at the bottom of page 4 of the Office Action of May 1, 2009. The observation is made that "while the notches may break (sic) up the salt they do not appear to cause the seasoning to fall". It is submitted, however, that such discussion does not operate to support the rejection which has been formulated under 35 U.S.C. §112, first paragraph.

As has previously been noted, by breaking up the salt under the influence of the notches, the salt is then caused to fall into the grinder under the influence of gravity. It appears that in response to this observation, the Examiner is taking the position that "if one holds (sic) the device horizontally, ...there is no force of gravity involved (sic) [and in such case, the notches] do not cause the salt (sic) to fall anywhere". However, if that is the case, then the grinding mill would under

such circumstances be rendered inoperative because the salt could not be introduced into the grinder. It is respectfully submitted that this is not a proper basis for formulating a rejection of claims under 35 U.S.C. §112, first paragraph.

Rather, as is noted with reference to Section 2163.02 of the Manual of Patent Examining Procedure:

Whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that... applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

Section 2163.02 of the Manual of Patent Examining Procedure further provides instruction for determining when possession of a claimed invention has been demonstrated, stating that:

Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings... that show that the invention was complete.... See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997)....

This has been demonstrated in the present case when considering that language corresponding to the recited elements of rejected claim 11 can be found in the specification originally submitted for this Patent Application, and implemented embodiments of the invention which incorporate such recited

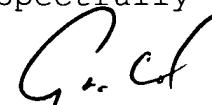
elements have been illustrated in the drawings. Referring to the "Guidelines for the Examination of Patent Applications..." presented in Section 2163 of the Manual of Patent Examining Procedure:

A specification may describe an actual reduction to practice by showing that the inventor constructed an embodiment... that met all the limitations of the claim and determined that the invention would work for its intended purpose (citing *Cooper v. Goldfarb*, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998)).

It is, therefore, respectfully submitted that claims 8, 11 and 20, are in full compliance with the written description requirement of 35 U.S.C. §112, first paragraph. Reconsideration and withdrawal of this formulated rejection is also respectfully requested.

Noting page 4 of the Office Action, which indicates that the previously formulated rejections of claims under 35 U.S.C. §112, second paragraph, and under 35 U.S.C. §103(a) as being unpatentable over the previously cited DE 29 22 656, are no longer relied on, it is respectfully submitted that in view of the foregoing, this Patent Application is in condition for allowance and corresponding action is earnestly solicited.

Respectfully submitted,

  
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